

## **REMARKS**

Applicant respectfully requests reconsideration of the subject application for the reasons set forth herein.

### **Amendment After Final**

Entry of this amendment is respectfully requested on the ground that this amendment places the application in condition for allowance. Alternatively, entry of this amendment is respectfully requested on the ground that this amendment places the claims in better form and condition for appeal. Furthermore, Applicant submits that any changes made to the claims herein do not require an additional search on the part of the Office, nor do any amendments made herein raise new issues with regard to the patentability of the claims now pending.

### **35 U.S.C. § 103(a) Rejections**

Claims 1-16 stand rejected as being unpatentable over Lohtia et al, U.S. Patent Publication Serial No. 2003/0211845 (“Lohtia”), in view of Laursen et al, U.S. Patent No. 6,233,608 (“Laursen”). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. § 103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Hence, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching, motivation, or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis added). M.P.E.P. 706.02(j).

Furthermore, in limited circumstances, common knowledge may be used to support a finding of obviousness if no other documented evidence is set forth and the Examiner takes "Official Notice" of such common knowledge. M.P.E.P. 2144.03. However, it is not proper for an Examiner to take Official Notice of a fact without citing to a reference where the fact asserted to be of common knowledge is not capable of being immediately and indisputably shown as being of common knowledge." *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970). M.P.E.P. 2144.03. In addition, if an Examiner is deficient in supporting the existence of a fact in making a conclusion by either failing to cite a proper reference or failing to take Official Notice of a fact, an applicant may note the deficiency, whereafter the Examiner must support the fact or finding by adequate evidence. 37 C.F.R. § 1.104(c)(2). M.P.E.P. 2144.03. If no such evidence is supplied, then no prima facie case of obviousness exists. *In re Ahlert*, 424 F.2d at 1091.

No Support is Given for the Statement that Laursen and Lohtia Make the System Efficient

In the Response to Arguments section of the present Office Action, it states: "Applicant's arguments filed on 3/15/2006 have been fully considered but they are not persuasive. In this

case, Laursen in the method of Lohtia to make the system efficient in terms of communication with data network through wireless means.” *Office Action of June 5, 2006*, page 5. Applicant respectfully traverses these characterizations for at least the following reasons.

Applicant respectfully, but emphatically, restates the above pertinent parts of law: to establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the references or combine reference teachings and the prior art references must teach or suggest all claim limitations. *In re Vaeck*, 947 F.2d 488. M.P.E.P. 706.02(j). The teaching, motivation, or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (emphasis added). M.P.E.P. 706.02(j). If an Examiner is deficient in supporting the existence of a fact in making a conclusion by either failing to cite a proper reference or failing to take Official Notice of a fact, an applicant may note the deficiency, whereafter the Examiner must support the fact or finding by adequate evidence. 37 C.F.R. § 1.104(c)(2). M.P.E.P. 2144.03. If no such evidence is supplied, then no prima facie case of obviousness exists. *In re Ahlert*, 424 F.2d at 1091.

First, the present Office Action fails to support facts used to characterize Applicant’s invention as obvious. The present Office Action states “Laursen in the method of Lohtia to make the system efficient in terms of communication with data network through wireless means.” *Office Action of June 5, 2006*, page 5. Nowhere before or after this sentence (or in any part of this discussion) is there any specific citation to Laursen or Lohtia (or any citation, in general) to back up the statement that the two references “make the system efficient.” Because this statement is unsupported in the present Office Action, Applicant submits that no suggestion or motivation to modify the references or combine reference teachings exists. Therefore,

Applicant respectfully asserts that the elements required to show a prima facie case of obviousness do not exist and, thus, Applicant's invention is patentable.

Applicant submits that it is improper for the Office Action to state, as a fact, that Laursen and Lohtia "make the system efficient" without supporting such statement with a reference. Applicant respectfully reiterates that, if a reference is not cited to support a statement of fact made, the Examiner *cannot rely on Applicant's disclosure* to make a statement of fact, as held in *In re Vaeck*. The Office Action fails to point out where this statement is supported in Lohtia or Laursen (or another reference). Applicant's invention discloses that efficiencies may be enjoyed by employing Applicant's system and method. However, the Office Action cannot rely on the disclosures in Applicant's invention as evidence of motivation to combine references. Because this statement in the present Office Action is unsupported and the Examiner may not rely on Applicant's disclosure, Applicant submits that no suggestion or motivation to modify the references or combine reference teachings exists.

Applicant submits that it is improper for the Office Action to state, as a fact of common knowledge, that Laursen and Lohtia "make the system efficient," unless the Examiner takes Official Notice of such fact. As stated above, this statement is unsupported. Under 37 C.F.R. § 1.104(c)(2) and M.P.E.P. 2144.03, Applicant respectfully requests that the Examiner take Official Notice of the facts in such statement in order to allow prosecution of Applicant's invention to proceed. If the Examiner does not produce evidence to support such statement or take Official Notice of the content of the statement, Applicant submits that no suggestion or motivation to modify the references or combine reference teachings exists. To that extent, Applicant respectfully submits that Applicant's invention is not obvious.

No Support is Given for the Statement of What One of Ordinary Skill in the Art Would Know Regarding Sending Information From a Wireless Carrier

In the Response to Arguments section of the present Office Action, it states: "Applicant's arguments filed on 3/15/2006 have been fully considered but they are not persuasive. One of ordinary skill in the art at the time of the invention knows that information sending from a wireless carrier as browser messages is the same as sending local information from a wireless handset to a web server." *Office Action of June 5, 2006*, page 5-6. Applicant respectfully traverses these characterizations for at least the following reasons.

Applicant again, respectfully, but emphatically, restates the above pertinent parts of law: to establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the references or combine reference teachings and the prior art references must teach or suggest all claim limitations. *In re Vaeck*, 947 F.2d 488. M.P.E.P. 706.02(j). The teaching, motivation, or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (emphasis added). M.P.E.P. 706.02(j). If an Examiner is deficient in supporting the existence of a fact in making a conclusion by either failing to cite a proper reference or failing to take Official Notice of a fact, an applicant may note the deficiency, whereafter the Examiner must support the fact or finding by adequate evidence. 37 C.F.R. § 1.104(c)(2). M.P.E.P. 2144.03. If no such evidence is supplied, then no prima facie case of obviousness exists. *In re Ahlert*, 424 F.2d at 1091.

The present Office Action fails to support facts used to characterize Applicant's invention as obvious. The present Office Action states "[o]ne of ordinary skill in the art at the time of the invention knows that information sending from a wireless carrier as browser messages is the

same as sending local information from a wireless handset to a web server.” *Office Action of June 5, 2006*, page 5-6. Nowhere before or after this statement (or in any part of this discussion) is there any specific citation to any reference to support the validity of it. Because this statement is unsupported, Applicant is prevented from prosecuting this statement further. Therefore, Applicant respectfully asserts that, because no support is set forth for the statement, no suggestion or motivation to modify the references or combine reference teachings exists. Therefore, Applicant respectfully asserts that the elements required to show a prima facie case of obviousness do not exist and, thus, Applicant’s invention is patentable.

Applicant submits that it is improper for the Office Action to rely on an unsupported statement to deem Applicant’s invention obvious. The Office Action has set forth unsupported facts of what one of ordinary skill in the art would know. Under 37 C.F.R. § 1.104(c)(2) and M.P.E.P. 2144.03, Applicant respectfully requests that the Examiner take Official Notice of these facts in such statement in order to allow prosecution of Applicant’s invention to proceed. If the Examiner does not produce evidence to support such statement or take Official Notice of the content of the statement, Applicant submits that no suggestion or motivation to modify the references or combine reference teachings exists. To that extent, Applicant respectfully submits that Applicant’s invention is not obvious.

No Support is Given for the Statement of What One of Ordinary Skill in the Art Would Know Regarding Sequencing of a Phone

Also, in the Response to Arguments section of the present Office Action, it states: “Applicant’s arguments filed on 3/15/2006 have been fully considered but they are not persuasive. One of ordinary skill in the art at the time of the invention knows that the sequencing of the phone can communicate with the link server where the link is also be a web

server.” *Office Action of June 5, 2006*, page 6. Applicant respectfully traverses these characterizations for at least the following reasons.

Applicant again respectfully, but emphatically, restates the above pertinent parts of law: to establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the references or combine reference teachings and the prior art references must teach or suggest all claim limitations. *In re Vaeck*, 947 F.2d 488. M.P.E.P. 706.02(j). The teaching, motivation, or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (emphasis added). M.P.E.P. 706.02(j). If an Examiner is deficient in supporting the existence of a fact in making a conclusion by either failing to cite a proper reference or failing to take Official Notice of a fact, an applicant may note the deficiency, whereafter the Examiner must support the fact or finding by adequate evidence. 37 C.F.R. § 1.104(c)(2). M.P.E.P. 2144.03. If no such evidence is supplied, then no prima facie case of obviousness exists. *In re Ahlert*, 424 F.2d at 1091.

The present Office Action fails to support facts stated in which it uses to characterize Applicant's invention as obvious. The present Office Action states “[o]ne of ordinary skill in the art at the time of the invention knows that the sequencing of the phone can communicate with the link server where the link is also be a web server.” *Office Action of June 5, 2006*, page 6. Nowhere before or after this sentence (or in any part of this discussion) is there any specific citation to any reference to support the validity of it. Because this statement is unsupported, Applicant submits no way exists to determine if it is true and, thus, Applicant is prevented from prosecuting this statement further. Therefore, Applicant respectfully asserts that, because no support is set forth for the statement, no suggestion or motivation to modify the references or

combine reference teachings exists. Therefore, Applicant respectfully asserts that the elements required to show a prima facie case of obviousness do not exist and, thus, Applicant's invention is patentable.

Applicant submits, again, that it is improper for the Office Action to rely on an unsupported statement to deem Applicant's invention obvious. The Office Action has set forth unsupported facts of what one of ordinary skill in the art would know. Under 37 C.F.R. § 1.104(c)(2) and M.P.E.P. 2144.03, Applicant respectfully requests that the Examiner take Official Notice of these facts in such statement in order to allow prosecution of Applicant's invention to proceed. If the Examiner does not produce evidence to support such statement or take Official Notice of the content of the statement, Applicant submits that no suggestion or motivation to modify the references or combine reference teachings exists. To that extent, Applicant respectfully submits that Applicant's invention is not obvious.

No Support is Given for the Statement of What One of Ordinary Skill in the Art Would Know Regarding a Server

Also, in the Response to Arguments section of the present Office Action, it states: "Applicant's arguments filed on 3/15/2006 have been fully considered but they are not persuasive. One of ordinary skill in the art at the time of the invention knows that the server is define as a processor that process the service request." *Office Action of June 5, 2006*, page 6. Applicant respectfully traverses these characterizations for at least the following reasons.

Applicant again respectfully, but emphatically, restates the above pertinent parts of law: to establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the references or combine reference teachings and the prior art references must teach or suggest all claim limitations. *In re Vaeck*, 947 F.2d 488. M.P.E.P. 706.02(j). The teaching,

motivation, or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (emphasis added). M.P.E.P. 706.02(j). If an Examiner is deficient in supporting the existence of a fact in making a conclusion by either failing to cite a proper reference or failing to take Official Notice of a fact, an applicant may note the deficiency, whereafter the Examiner must support the fact or finding by adequate evidence. 37 C.F.R. § 1.104(c)(2). M.P.E.P. 2144.03. If no such evidence is supplied, then no prima facie case of obviousness exists. *In re Ahlert*, 424 F.2d at 1091.

The present Office Action fails to support facts stated in which it uses to characterize Applicant's invention as obvious. The present Office Action states "[o]ne of ordinary skill in the art at the time of the invention knows that the server is define as a processor that process the service request." *Office Action of June 5, 2006*, page 6. Nowhere before or after this sentence (or in any part of this discussion) is there any specific citation to any reference to support the validity of it. Because this statement is unsupported, Applicant submits no way exists to determine if it is true and, thus, Applicant is prevented from prosecuting this statement further. Therefore, Applicant respectfully asserts that, because no support is set forth for the statement, no suggestion or motivation to modify the references or combine reference teachings exists. Therefore, Applicant respectfully asserts that the elements required to show a prima facie case of obviousness do not exist and, thus, Applicant's invention is patentable.

Applicant submits that it is improper for the Office Action to rely on an unsupported statement to deem Applicant's invention obvious. The Office Action has set forth unsupported facts of what one of ordinary skill in the art would know. Under 37 C.F.R. § 1.104(c)(2) and M.P.E.P. 2144.03, Applicant respectfully requests that the Examiner take Official Notice of these

facts in such statement in order to allow prosecution of Applicant's invention to proceed. If the Examiner does not produce evidence to support such statement or take Official Notice of the content of the statement, Applicant submits that no suggestion or motivation to modify the references or combine reference teachings exists. To that extent, Applicant respectfully submits that Applicant's invention is not obvious.

#### Lohtia and Laursen Do Not Teach the Sequence of Steps of the Present Invention

Independent Claims 1 and 7 both disclose a method for sending local information from a wireless handset to a Web server "comprising... [receiving] a service request...; ...acquiring the local information, from the handset...and ...sending the local information to the Web server from the wireless handset via a uniform resource locator, wherein the phone dialing process is modified to send the local information as part of the uniform resource locator." Neither Lohtia nor Laursen teaches the sequence of steps disclosed in Applicant's Claims 1 and 7.

Applicant submits that the present Office Action stated that "...Lohtia discloses [this] method for sending local information from a wireless handset to a web server...(Page. 1, Paragraph 0004)..." *Office Action of December 15, 2005*, page 2. However, Applicant respectfully submits that Lohtia does not disclose a method of sending local information from a *wireless handset* to a *Web server*. Instead, Lohtia discloses a method wherein a WWIS Gateway "collects...information..., formats the information and sends it to the users' handsets..." Lohtia, p. 1, paragraph 4. The steps recited from Lohtia make up a method of sending information *to a wireless handset* from a web server, wherein Applicant's invention is a method of sending information *from a wireless handset to a Web server*. Not only does Lohtia fail to disclose each of the steps of Applicant's invention, Lohtia also fails to encompass the spirit of Applicant's

invention, namely sending local information *from a wireless handset to a Web server*. Because Lohtia discloses a different method as disclosed by Applicant, Applicant submits that Lohtia does not teach each the sequence of steps in Claims 1 and 7 as disclosed in Applicant's invention.

Furthermore, Applicant respectfully submits that Laursen, likewise, fails to disclose the sequence of steps disclosed in Claims 1 and 7. Applicant respectfully submits that the present Office Action asserts that Lohtia does not describe in detail "sending local information...to a Web server...[by receiving] a service request..., acquiring the local information; and ...sending the local information to the Web server from the wireless handset via a uniform resource locator....," as disclosed in Claims 1 and 7. *Office Action of December 15, 2005*, page 2. The present Office Action then asserts that Laursen teaches this step in:

The communication protocol in the Internet 104 is the well known HyperText Transfer Protocol or HTTP and runs on TCP and controls the connection of a well known HyperText Markup Language Web browser, or HTML Web browser, to a Web server and the exchange of information therebetween. Col. 6, lines 33-38.

Each mobile phone is assigned to a device ID 140 which can be a phone number of the phone or a combination of an IP address and a port number, for example: 204.163.165.132:01905 where 204.163.165.132 is the IP address and 01905 is the port number. Col. 7, lines 57-61.

The screen 116 prompts user what to proceed with the keypad 118, with a sequence of key entries and through the phone 160, a user can interactively communicate with a server through the airnet, link server and the Internet. Col. 9 lines 28-31. *Office Action of December 15, 2005*, page 2.

However, the Laursen reference discloses HTTP, device IDs, and the use of a keypad to connect to a server through the airnet, but does not disclose the *sequence* of steps as disclosed in Applicant's invention. The Laursen reference fails to disclose the sequence of steps of sending local information *from a wireless handset to a Web server* via a uniform resource locator. Thus,

Applicant respectfully submits that Laursen fails to teach all elements of Claims 1 and 7 and, as such, fails to teach the method disclosed in Applicant's invention.

As stated above, Applicant respectfully asserts neither Lohtia nor Laursen alone teach the sequence of steps disclosed in Applicant's invention, not does the present Office Action assert that they do. Furthermore, Applicant respectfully submits that it is not logically possible to modify the sequence of steps disclosed in Lohtia with disclosures in Laursen to arrive at Applicant's invention, as asserted in the present Office Action. Lohtia discloses a sequence wherein information is flowing from the Web to a wireless user based on the user's request for information. *See Lohtia*, Figure 2. If the elements disclosed in Lohtia were modified with the disclosures in Laursen regarding HTTP, device IDs, and the use of a keypad to connect to a server through the airnet (Laursen, col. 6, lines 33-38; col. 7, lines 57-61; and col. 9 lines 28-31), an impossibility would exist because the system in Lohtia does not disclose acquiring local information *from the wireless handset*, and *sending* the local information *to a Web server* from a wireless handset. *See, generally, Lohtia*. Because the system in Lohtia would be wholly inoperable, even considering the modification with Laursen, when the steps in Lohtia are combined with the disclosures in Laursen, no reasonable expectation of success exists. Thus, Applicant respectfully asserts that Applicant's invention is not obvious.

Therefore, Applicant submits that the cited references of Lohtia and Laursen, neither individually nor in combination, teach or suggest the sequence of steps as taught in independent Claims 1 and 7 of Applicant's invention.

Accordingly, Applicant submits that at least amended, independent Claims 1 and 7 of Applicant's invention are patently distinguishable over the prior art of record. Applicant further

submits that each of the dependent claims (Claims 2-6 and 8-13) is similarly distinguishable over the prior art of record, at least by virtue of each Claim's ultimate dependency from the patently distinct base Claims 1 and 7.

Lohtia and Laursen Do Not Teach a System which Sends Local Information from a Wireless Handset to a Web Server via a Uniform Resource Locator

Amended independent Claim 14 discloses a "system comprising:...a wireless handset comprising a transceiver for sending...communications...via a wireless data transmission passing through...an Internet browser configured to accept a user input comprising...a service request comprising a type of local information needed to carry out the request and a URL address; and a Web server located at the URL address contained in the service request..., the Web server receiving...local information from the Internet browser and carrying out the service request based on the local information, wherein the phone dialing process is modified to send the local information as part of the uniform resource locator." Neither Lohtia nor Laursen teaches the invention in Applicant's amended Claim 14.

Applicant submits that the present Office Action stated that "...Lohtia did not disclose in detail "sending the local information to the Web server via uniform source locator [w]herein the phone dialing process is modified to send the local information as part of the uniform source locator," which is also an element of amended Claim 14. *Office Action of December 15, 2005*, page 2. Thus, Applicant submits that Lohtia does not teach each and every element of Claim 14, as disclosed in Applicant's invention.

Furthermore, Applicant respectfully submits that Laursen, likewise, fails to disclose the invention disclosed in amended Claim 14. The present Office Action asserts that Laursen teaches the element of a "Web server receiving...local information from the Internet browser and

carrying out the service request based on the local information, wherein the phone dialing process is modified to send the local information as part of the uniform resource locator” in the following passages:

The communication protocol in the Internet 104 is the well known HyperText Transfer Protocol or HTTP and runs on TCP and controls the connection of a well known HyperText Markup Language Web browser, or HTML Web browser, to a Web server and the exchange of information therebetween. Col. 6, lines 33-38.

Each mobile phone is assigned to a device ID 140 which can be a phone number of the phone or a combination of an IP address and a port number, for example: 204.163.165.132:01905 where 204.163.165.132 is the IP address and 01905 is the port number. Col. 7, lines 57-61.

The screen 116 prompts user what to proceed with the keypad 118, with a sequence of key entries and through the phone 160, a user can interactively communicate with a server through the airnet, link server and the Internet. Col. 9 lines 28-31. *Office Action of December 15, 2005*, page 2-3.

However, Laursen discloses HTTP, device IDs, and the use of a keypad to connect to a server through the airnet, but does not disclose modifying the phone dialing process to send local information as a part of the uniform resource locator, as disclosed in Applicant’s invention. The disclosures in Laursen, even when viewed broadly, fail to embrace the spirit of Applicant’s invention of a system which sends local information *from a wireless handset to a Web server* via a uniform resource locator. Thus, Applicant respectfully submits that the disclosures in Laursen fail to teach the elements of amended Claim 14 and thus, the shortcomings in the teachings of Lohtia are not remedied by the addition of Laursen. Because Lohtia, in view of Laursen, fail to disclose all elements of amended Claim 14, Applicant respectfully asserts that amended, independent Claim 14 is not obvious.

Accordingly, Applicant submits that at least amended, independent Claim 14 of Applicant’s invention is patently distinguishable over the prior art of record. Applicant further

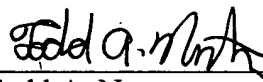
submits that each of the dependent claims (Claims 15 and 16) are similarly distinguishable over the prior art of record, at least by virtue of each Claim's ultimate dependency from the patently distinct base Claim 14.

### **Conclusion**

Wherefore, Applicant respectfully believes all outstanding grounds raised by the Examiner have been addressed, and thus respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Respectfully Submitted,

**REED SMITH LLP**

A handwritten signature in black ink, appearing to read "Todd A. Norton", is written over a horizontal line.

Todd A. Norton

Reg. No. 48,636

Thomas J. McWilliams

Reg. No. 44,930

**REED SMITH LLP**

1650 Market Street

2500 One Liberty Place

Philadelphia, PA 19103

Phone 215.851.8100

Fax 215.851.1420

Attorneys for Applicant